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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,601	08/20/2003	Samuel Masket	MSKT1P001	5570
22434	7590	09/18/2007	EXAMINER	
BEYER WEAVER LLP				THALER, MICHAEL H
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ART UNIT		PAPER NUMBER		
		3731		
MAIL DATE		DELIVERY MODE		
		09/18/2007		
		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/644,601	MASKET, SAMUEL
	Examiner Michael Thaler	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-37 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 16-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/20/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant is advised that should claim 24 be found allowable, claim 37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 16-30 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ocel et al. (4,044,770). Ocel discloses component 15 (which is inherently capable of making a mark on a lens capsule by pressing on it to make a physical impression or indentation on it), the marking component having an associated size which is inherently adjustable by the user (for example, the thin loop 15 could be manually deformed to make it thinner or wider) and delivery mechanism 12 which is inherently capable of being inserted into an anterior chamber of an eye due to the small size of the delivery mechanism. Alternatively, it would have been obvious that component 15 is capable of making a mark on a lens capsule by pressing on it since this action would apparently make a physical impression or indentation on it.

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Claims 16, 31 and 33-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Burton (4,665,912). Burton discloses marking component (the portion of needle 30 that extends from the end 36 of tip 34 and which is inherently capable of making a mark on a lens capsule), the marking component having an associated size which is adjustable by the user (by extending or retracting the needle into the tip 34) and delivery mechanism 34 which is inherently capable of being inserted into an anterior chamber of an eye due to the small size of the delivery mechanism. Alternatively, it would have been obvious that the marking component is capable of making a mark on a lens capsule since it is small. As to claim 36, the distal portion of tip 34 (which is ring shaped) is considered to be the marking component.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burton (4,665,912). Burton fails to disclose the retraction/extension mechanism as being screw-type. However, it is old and well known in the art to make a retraction/extension mechanism of a medical instrument screw-type (as admitted by applicant on page 10, lines 8-11 of applicant's specification) in order to obtain the well known advantage of very precisely controlling the retraction or extension of the instrument. It would have been obvious to make

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the Burton retraction/extension mechanism screw-type so that it too would have this advantage.

Applicant's arguments with respect to claims 16-37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731

mht